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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/565,719

01/25/2006

Ashok M. Adur

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35227 7590 07/22/2010

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EXAMINER

LENIHAN, JEFFREY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|--------------------------------------|---------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/565,719 | Applicant(s) ADUR, ASHOK M. | |
| | Examiner Jeffrey Lenihan | Art Unit 1796 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 8,10,11 and 13-15.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/ Irina S. Zemel/
 Primary Examiner, Art Unit 1796

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 8, 10, 11, and 13-15 under 35 USC 112, 1st paragraph is withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because:

The claiming of a new use, new function, or unknown property which is inherently present in the prior art does not necessarily make the claim patentable; see *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention; see *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). The claimed invention is a process comprising the steps of 1) adding a combination of nucleating agents to the thermoplastic phase of a thermoplastic elastomer, 2) injection molding the thermoplastic elastomer to form an article, and 3) allowing the thermoplastic elastomer in the article to cool. As discussed in the previous Office Actions, incorporated herein by reference, the prior art renders obvious a process comprising the claimed steps using the claimed combination of nucleating agents. The claimed limitation of a reduction in cycle time therefore will be met by the process rendered obvious by the prior art.

Regarding the allegedly unexpected results: Excerpts from Drobny, Handbook of Thermoplastic Elastomers, and Harper, Modern Plastics Handbook, were provided to applicant as part of the Office Action mailed on 7/28/2009. As noted in the Office Actions mailed on 11/04/2009 and 7/28/2008, incorporated herein by reference, these references teach that it was known in the art of polymer chemistry at the time the invention was made that the addition of a nucleating agent to a polymer results in an increased rate of crystallization and a reduction in the molding cycle time. It is therefore not an unexpected result to merely state that the cycle time of a polymer composition containing the claimed nucleating agent is less than that of a polymer composition which does not contain the nucleating agent.

Regarding applicant's argument that a comparison of inventive examples 10 and 11 to comparative examples C3-C5 is indicative of patentability: To rebut a prima facie case of obviousness, applicant may show that there are new or unexpected results relative to the prior art; see *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1322, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004). As noted in the previous Office Actions, the specification states that comparative examples C3-C5 are unmodified compositions (specification, page 22, lines 9-12; Table 5)-that is, they do not contain a nucleating agent. However, the primary reference explicitly teaches the use of a nucleating agent; the comparative examples C3-C5 therefore do not correspond to the prior art. Additionally, the reduction of cycle time by approximately 22% shown in Examples 10 and 11 may be unexpected; however, applicant has not provided data from even a single comparative example regarding the degree by which cycle time is reduced in the process using the nucleating agent of the primary reference. Applicant therefore has not provided any factual evidence/data which demonstrates that a 22% reduction in cycle time is an unexpected result.

The examiner disagrees with applicant's statement that the Office Action required applicant to "provide the amount of unexpectedness." The previous Office Actions stated that applicant has not provided data "regarding the degree by which cycle time is reduced when a comparable amount of the prior art nucleating agent is used." In the case of Examples 10 and 11 in the instant specification, the degree by which cycle time is reduced is approximately 22%; as stated above, applicant has not provided data to show by what degree (i.e., percentage) the cycle time is reduced in the prior art.